



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,967	11/21/2001	Travis J. Parry	10008078-1	1662

7590 03/15/2006

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

SCUDERI, PHILIP S

ART UNIT	PAPER NUMBER
----------	--------------

2153

DATE MAILED: 03/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/989,967	PARRY, TRAVIS J.	
	Examiner	Art Unit	
	Philip S. Scuderi	2153	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to applicant's amendment filed on 05 December 2005.

Claim Objections

The objection to claim 11 has been withdrawn because applicant's amendments have overcome the objection.

Claim Rejections - 35 USC § 112

The rejection of claim 11 under 35 USC § 112, second paragraph has been withdrawn because applicant's amendments have overcome the rejection.

The rejection of claims 13-20 under 35 USC § 112, second paragraph have been withdrawn because the examiner finds applicant's arguments persuasive, see page 5-6, filed on 05 December 2005. The examiner's assertion that it is unclear which devices are considered "similar to" other devices was incorrect for the reasons cited by applicant. The examiner has concluded that these claims are broad, but not indefinite.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

Art Unit: 2153

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-8, and 11 are rejected under 35 U.S.C. 102 as being anticipated by Admitted Prior Art (figure 1; background section of the specification) (hereinafter “APA”). See MPEP § 2129.

Regarding claim 1, APA teaches an imaging device comprising:

an image generator (110), wherein the image generator is a print engine (paragraph 0002, lines 8-10);

a network interface (paragraph 0004, lines 12-14); and

a controller (104) coupled to the network interface and the image generator (figure 1; via network backplane 100), wherein the controller is adapted to store a list of other network addresses (paragraph 0005, lines 1-3).

The preamble has not been given patentable weight because a preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535

Art Unit: 2153

F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Regarding claim 2, APA teaches that the list of other network addresses further comprises a list of other imaging device network addresses (paragraphs 0004-0005; e.g., the address of imaging device 102).

Regarding claim 3, APA teaches that the list of other imaging device network addresses further comprises

Regarding claim 4, APA teaches that the controller (104) is adapted to store a list of other network addresses in a register (paragraph 0005; wherever the management facility 104 stores the list of other addresses reads on a register).

Regarding claim 6, APA teaches that the list of other network addresses is in a sequential list (paragraph 0005).

Regarding claim 7, APA teaches that the controller (104) is adapted to discover the list of other network addresses (paragraph 0005, lines 5-6).

Regarding claim 8, APA teaches that discovering the list of other network addresses further comprises discovering the list of other network addresses with a manner selected from the group consisting of querying network addresses for known device specific interface protocols, generally

Art Unit: 2153

broadcasting a device identification protocol for specific device types to respond to, and pinging network addresses (paragraph 0005; the devices are discovered by management facility 104 which must inherently use at least one of the claimed manners for discovering the devices).

Regarding claim 11, APA teaches that a network device at a network address notifies the imaging device when the network device comes online (paragraph 0005; simply discovering a device notifies the management facility 104 that the device is online).

Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,965,931 (hereinafter "Helms").

Regarding claim 1, Helms teaches an imaging device comprising:
an image generator (402), wherein the image generator is a print engine (because it processes print jobs; column 7, line 66 – column 8, line 15);
a network interface (figure 4); and
a controller coupled to the network interface and the image generator (618), wherein the controller is adapted to store a list of other network addresses (column 7, lines 25-48).

Regarding claim 5, Helms teaches that the controller (618) further comprises an embedded webserver (column 7; lines 25-48).

Claims 1, 7, 9, 10, and 13-20 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2003/0055874 (hereinafter "Simpson")

Regarding claim 1, Simpson teaches an imaging device comprising:
an image generator, wherein the image generator is a print engine (figure 3, print server 350);
a network interface (figure 3, 324); and
a controller (358) coupled to the network interface and the image generator (paragraph 0038), wherein the controller is adapted to store a list of other network addresses (paragraph 0038).

Regarding claim 7, Simpson teaches that the controller (358) is adapted to discover the list of other network addresses (paragraph 0038).

Regarding claim 9, Simpson teaches that discovering the list of other network addresses is scheduled to occur at specific times (paragraph 0038).

Regarding claim 10, Simpson teaches a history list of previously valid network addresses utilized in discovering the list of other network addresses (the discovery database; paragraph 0038).

Regarding claims 13 and 15, Simpson teaches a method of operating an imaging device, the method comprising:

determining a list of network addresses (paragraph 0038) for other imaging devices (320/330) similar to the imaging device (320/330 are similar to print server 350 because they are on the same network 340);

storing the list of network addresses on the imaging device (paragraph 0038).

Regarding claims 14 and 16, Simpson teaches that the determining comprises discovering (paragraph 0038).

Regarding claim 17, Simpson teaches that the discovery manner comprises generally broadcasting a device identification protocol for specific device types to respond to (paragraph 0038).

Regarding claim 18, Simpson teaches notifying the imaging device when an imaging device associated with a network address of the list of network addresses for other imaging devices goes online (paragraph 0038).

Regarding claim 19, Simpson teaches storing additional information on the imaging device including image device usage information (image device URLs; paragraph 0039).

Regarding claim 20, Simpson teaches directing the communication between the imaging device and the other similar imaging devices with a webserver embedded in the imaging device (paragraph 0038).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

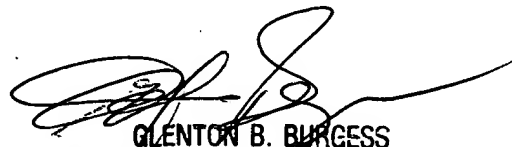
Art Unit: 2153

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip S. Scuderi whose telephone number is (571) 272-5865. The examiner can normally be reached on Monday-Friday 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton B. Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PSS



GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100